

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 21

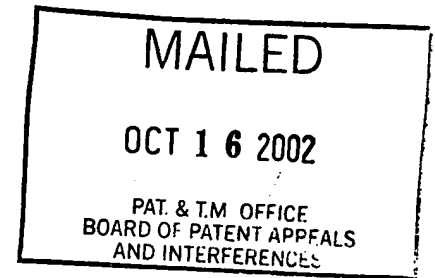
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BENJAMIN J. KWITEK

Appeal No. 2001-2224  
Application No. 09/173,445

ON BRIEF



Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This case comes before us again on request for rehearing of our decision of November 29, 2001, wherein we affirmed the examiner's rejection of claims 1, 3, 7-10, 14 and 21-29, all the claims pending in the application, under 35 U.S.C. § 103 as being unpatentable over Minami in view of Huang and Moore. Appellant's request "revolves around the obviousness of modifying the grip disclosed by Minami based upon the disclosure of Huang" (request, page 2). In addition, the tenor of appellant's argument

as a whole is that the application of the teachings of the applied references in reaching a conclusion of obviousness is improper as being based upon impermissible hindsight.

Appellant's arguments in the request have caused us to reconsider the manner in which the teachings of the prior art have been applied against the claims. While we remain of the view of the reference evidence adduced by the examiner is sufficient to establish a *prima facie* case of obviousness of the subject matter of the appealed claims, we now perceive that potential problems exist in justifying a rejection of the appealed claims utilizing Minami as the starting point. More particularly, we now consider that it would have been more appropriate to reject the claims as being unpatentable over the combined teachings of Huang and Moore alone. Accordingly, we *grant* appellant's request urging us to reverse the examiner's rejection and, pursuant to 37 CFR § 1.196(b), enter a new ground of rejection of the appealed claims based on the teachings of Huang and Moore alone.

Claims 1, 3, 7-10, 14 and 21-29 are rejected under 35 U.S.C. § 103 as being unpatentable over Huang in view of Moore.

Huang pertains to an improved shock absorbing grip for a tennis racket or golf club. The grip comprises an elongated strip S which is spirally wound around the handle of the racket or club and adhered thereto by adhesive 38. The strip S includes an open-pored felt layer 22 and a smooth closed pore polyurethane layer 26 bonded to the felt layer. In Figures 11-14, Huang discloses a so-called slip-on replacement grip for a golf club. The replacement grip comprises a resilient rubber-like sleeve 60 of synthetic plastic foam or rubber (column 6, lines 20-22) and a strip S spirally wound around the sleeve and adhered thereto. The sleeve 60 includes a raised shoulder portion in the form of cap 62 at one end and a raised shoulder portion in the form of guide cylinder 64 at the other end. As may be readily seen upon review of Figures 11-14, the strip S is spirally wound around the sleeve in the area defined between the raised shoulder portions.

Moore, in pertinent part, is directed to a custom fit hand grip for a sports racket, such as a tennis racket or golf club (column 14, lines 51-53). Moore's grip comprises a gel material 57, which may include an uncured silicon rubber (column 5, lines 34-60), encased in an airtight elastomeric envelope 59, 64 (column 4, lines 34-42; column 3, lines 54-57). According to Moore:

A member, such as a gel pad or gel-filled envelope, is provided which comprises a body of formable material having a minimum setting temperature greater than 130° F. and being settable by heating for a period not exceeding 30 minutes and subsequent cooling. The member is conformed by biasing it against a body part of a person or mammal with sufficient pressure to conform the member to the shape of the body part. The member is then heated for a period not exceeding 30 minutes and thereafter cooled so that the formable material is set and the member remains flexible while resiliently retaining an impression of the body part. [Abstract.]

As stated by Moore, a custom fit grip of the type disclosed therein provides for greater user comfort and more even distribution of the pressure (column 1, lines 23-27).

It would have been obvious to one of ordinary skill in the art at the time of appellant's invention to replace the strip-like grip element S of Huang's Figures 11-14 replacement grip with a custom fit grip like that disclosed in Moore in order to derive the benefits disclosed in Moore that such custom fit grips provide, namely, greater user comfort and more even distribution of pressure. In so doing, we consider that the subject matter of appealed claims 1, 7, 21 and 23 would result. In this regard, Moore's "gel material" comprising uncured silicon rubber would be considered by one of ordinary skill in the art as corresponding to appellant's "viscous liquid," as called for in claims 1 and 21, and appellant's "silicone gel," as called for in claims 7 and 23, when these terms are given their broadest reasonable interpretation in light of appellant's

disclosure.<sup>1</sup> In addition, while we appreciate that the grip of Huang is intended to eventually be “set” such that the gel material in the envelope may no longer be considered a “viscous liquid” or “viscous gel” as set forth in the claims, this circumstance is of no consequence in that the modified Huang replacement grip, prior to its being set, would comprise a “viscous liquid” or “viscous gel” as claimed. Thus, it is the modified Huang grip, in its unset condition, that we regard as corresponding to the claimed subject matter.

Concerning the requirement of claims 1 and 21 setting forth the lip details of the tubular shell, the modified Huang replacement grip would include a tubular shell (Huang’s sleeve 60) having an outwardly extending first lip (Huang’s cap 62) adjacent the first end of the shell and an outwardly extending second lip (Huang’s guide cylinder 64) adjacent the second end of the shell. Moreover, the relationship between the grip element and the lips of the modified Huang replacement grip would be such that the depth as defined by the first and second lips would be substantially the same as the thickness of the hand surface to retain the hand surface, as called for in claim 1, and

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<sup>1</sup>Note, for example, the following portions of appellant’s specification: page 4, lines 6-7 (“the viscous liquid material is a silicone gel or silicone oil.”); page 7, lines 13-17 (“For example, the viscoelastic hand surface 12, 112 may be . . . a gelatinous material interposed within a more resilient material to contain the gelatinous material.”); page 10, lines 12-13 (“The viscous liquid 136 is preferably a silicone gel or oil . . .”).

such that the lips are shaped and dimensioned to retain the hand surface in position of the tubular shell, as called for in claim 21. This relationship is fairly taught by Huang (see, for example, Figures 12 and 13) and would be in keeping with Huang's desire to fashion the hand grip such that the edges to the grip element do not separate from the tubular shell, provide for a neat appearance, and do not interfere with other golf club grips when a golf club is removed from a golf bag so as to reduce wear and tear on such grips (column 6, lines 41-49).

Dependent claims 3, 8-10, 14, 22 and 24-29 are also rendered obvious in view of the teachings of Huang and Moore as applied above. The tubular shell construction called for in claims 3, 9, 10, 22, 25 and 26 is clearly taught by Huang. Huang's disclosure at column 6, lines 20-22, that the sleeve 60 of the replacement grip is a resilient element made of synthetic plastic foam or rubber would have, at the very least, suggested to one of ordinary skill in the art that the sleeve be made of a soft elastomer, as called for in claims 8, 14, 24 and 27. As to the requirement of claims 28 and 29 that the viscoelastic hand surface have a thickness between about 1/16 and 1/4 inch, providing a hand surface in the modified Huang replacement grip in this thickness range would have been obvious to one of ordinary skill in the art in view of Moore's

disclosure at column 10, lines 55-64, that the gel material thereof can be rolled into sheets 1/8 to 1/4 inch thick and sealed into an envelope.

Appellant's argument in the brief and request for rehearing have been considered. We simply do not agree with appellant's argument on pages 7 and 10 of the brief that Huang does not disclose the depth relationship set out in claim 1, or the shape and dimensions to retain the grip set out in claim 21. As we see it, the depth relationship is clearly shown in Figures 12 and 13, and the retaining function flows as a natural consequence from that relationship. Concerning appellant's argument on page 8 of the brief to the effect that there is no suggestion in the references themselves for their combination, clear suggestion for providing Moore's custom grip in Huang is found in Moore's disclosure at column 1, lines 23-27, that custom fit articles provide for greater user comfort and more even pressure distribution. Concerning appellant's observation on page 3 of the request that Huang is silent as to the function of the cap and guide cylinder, we do not consider this circumstance to be of consequence with respect to our new ground of rejection. In any event, we do not agree with appellant's argument on page 3 of the request that one of ordinary skill in the art would read into Huang's silence that the cap 62 and guide cylinder 64 perform no particular function. Rather, as in our previous decision, we continue in the belief that the ordinarily skilled

artisan would consider Huang's cap 62 and guide cylinder 64 as functioning to define the grip area and aid in retaining the grip in position.

In summary, appellant's request for rehearing asking us to reverse the examiner rejection is granted, and a new rejection pursuant to 37 CFR § 1.196(b) has been entered.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . . .



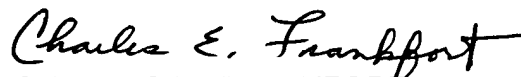
(2) Request that the application be reheard under  
§ 1.197(b) by the Board of Patent Appeals and Interferences  
upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

GRANTED; 37 CFR § 1.196(b)



NEAL E. ABRAMS  
Administrative Patent Judge



CHARLES E. FRANKFORT  
Administrative Patent Judge



LAWRENCE J. STAAB  
Administrative Patent Judge

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Howard N. Flaxman, Esq.  
AQUILINO & WELSH  
2341 Jefferson Davis Highway  
Suite 112  
Arlington, VA 22202